

Applicants. Also, the Applicants attached a copy of the partially considered 1449 to the *Amendment* filed January 10, 2005 (received January 12, 2005); however, the Image File Wrapper does not include a copy of this submission. Apparently, these documents were not included in the scanning process. As a courtesy to the Examiner, the Applicants have again attached a copy of the partially considered Form PTO-1449. It is noted that the Applicants are merely resubmitting the Form PTO-1449 as a courtesy to the Examiner. It is respectfully submitted that the above-referenced Information Disclosure Statement was properly filed on December 3, 1999, and should be accorded its filing date for the purposes of consideration and compliance with 37 CFR 1.97 and 1.98. The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of JP '967.

Also, despite an earlier request, the Applicants still have not received acknowledgment of the Information Disclosure Statement filed on August 26, 2003 (received by OIPE September 3, 2003). These papers appear in the Image File Wrapper with a mail room date of "09/03/2003." As a courtesy to the Examiner, the Applicants have attached a copy of the Form PTO-1449 from the Information Disclosure Statement filed August 26, 2003. It is noted that the Applicants are merely resubmitting the Form PTO-1449 as a courtesy to the Examiner. It is respectfully submitted that the above-referenced Information Disclosure Statement was properly filed on August 23, 1999, and should be accorded its filing date for the purposes of consideration and compliance with 37 CFR 1.97 and 1.98. The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Information Disclosure Statement filed August 26, 2003.

Claims 9-16, 21-24, 33-36, 50-52, 54 and 57-97 are pending in the present application, of which claims 9, 13, 21, 33, 57-59, 66, 69, 73, 77, 81, 85, 89 and 93 are independent. Claims 69-97 have been withdrawn from consideration (page 2, Paper No. 08042005). Accordingly, claims 9-16, 21-24, 33-36, 50-52, 54 and 57-68 are currently elected, of which claims 9, 13, 21, 33, 57-59 and 66 are independent. For the

reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 9-16, 21-24, 33-36, 50-52, 54 and 57-68 as obvious based on the combination of U.S. Patent No. 5,227,900 to Inaba et al., JP 61-141178 to Takeshita et al. and U.S. Patent No. 5,055,899 to Wakai et al. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Inaba, Takeshita and Wakai or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that

the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The Official Action asserts that the TFT shown in Figures 1 and 2 of Wakai (reproduced below) is similar to the TFT shown in Figure 5 of Inaba (reproduced below) and causes "a short-circuiting between the pixel electrode and the drain electrode" (page 2, Paper No. 08042005).

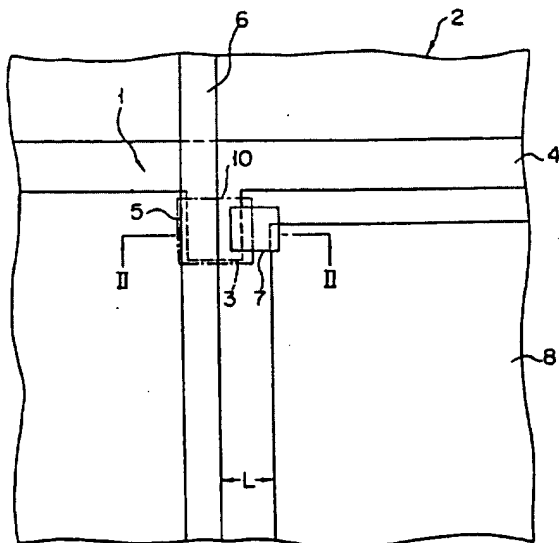


FIG. 1 (PRIOR ART)

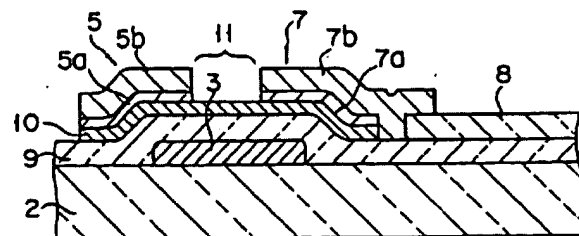
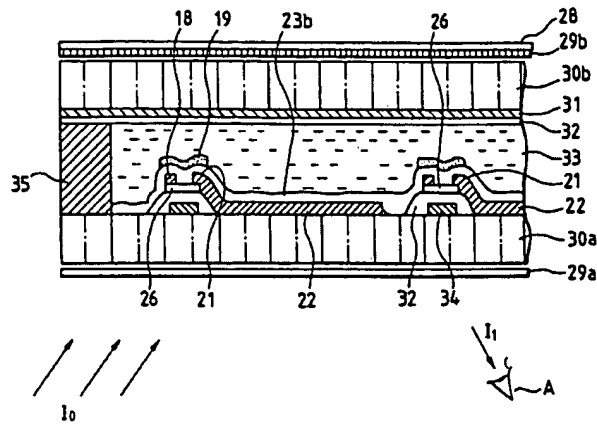
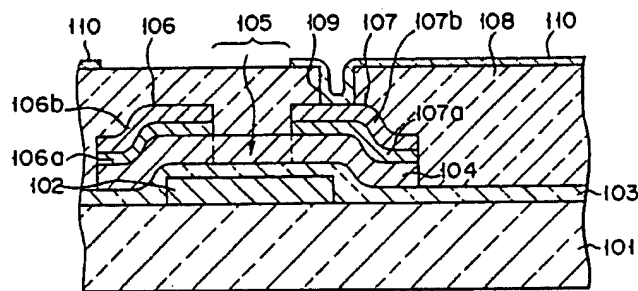


FIG. 2 (PRIOR ART)

FIG. 5



The Official Action implies that the TFT of Figure 5 of Inaba would have a short-circuiting problem similar to that discussed in Figures 1 and 2 of Wakai. The Official Action further asserts that "Wakai solves the short-circuiting problem by forming the insulation/leveling layer ... between the pixel electrode and the drain electrode" and that "it would have been obvious to one of ordinary skill in the art to employ an insulating/leveling layer ... for avoiding disadvantages including short-circuiting (pages 2-3, *Id.*). The Official Action, although not specific, appears to be referring to the insulating layer 108 of Wakai, illustrated in Figure 3 (reproduced below).



The Official Action appears to assert that Wakai's discussion of a short-circuiting problem cures all the deficiencies in Inaba and Takeshita as discussed in detail in the *Appeal Brief* filed June 7, 2004. Please incorporate by reference the detailed discussion of these references in the above-referenced *Appeal Brief* and in the

Response filed January 10, 2005. The Applicants respectfully disagree and traverse the above-referenced assertions in the Official Action.

In Figures 1 and 2 of Wakai (reproduced above), short-circuiting tends to occur between the transparent electrode (pixel electrode) 8 and the drain line 6 (column 6, lines 24-25). The Applicants note that the pixel electrode 8 and the drain line 6 are separated from each other, and that short-circuiting tends to occur due to relatively short distance L (Figure 1; column 2, lines 26-39).

Referring to Figure 5 of Inaba (reproduced above), the pixel electrode 22 is connected to the terminal 21 (source or drain electrode). However, Inaba fails to disclose a location of a line connected to the other terminal 18. Furthermore, Inaba fails to teach or suggest a distance between the pixel electrode 22 and a hypothetical line connected to the other terminal 18.

Although Inaba allegedly discloses a similar TFT structure to that of Wakai, the short-circuiting problem of Wakai would not have been applied to Inaba, because Inaba does not show a line connected to terminal 18. That is, nothing in the prior art or in the disclosure of Inaba teaches or suggests that short-circuiting was a problem for the device illustrated, for example, in Figure 5 of Inaba.


Therefore, the Applicant respectfully submits that the Official Action has not provided a proper suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Inaba, Takeshita and Wakai or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789